

REMARKS

This response relates to issues raised in the examiner's office action dated April 8, 2008. In that office action, claims 38-53 were rejected by the examiner under 35 U.S.C. § 102 and/or 35 U.S.C. § 103. Primary reference used by the examiner in rejecting the claims is Lash (US 5,728,117).

On pages 2 of the Office Action, the examiner rejects claims 38-48, 51 and 52 under 35 U.S.C. § 102 as being anticipated by Lash. On pages 4 and 5 of the Office Action, the examiner rejects claims 49, 50 and 53 under 35 U.S.C. § 103 as unpatentable over Lash in view of Keener Jr. and/or Nallakrishnan. These rejections are respectfully traversed.

As noted in paragraph [0005] of the specification of this published application (Pub No. US 2004/0106929 A1), conventional techniques of performing an anterior capsulorhexis surgery procedure have involved manual estimation by the surgeon wherein the surgeon manually estimates the location, shape, and size of the intended capsulorhexis without the aid of any guide or reference mark on the lens capsule. This holds true for the device of Lash, which employs a flexible band with a razor sharp serrated edge 24 on one side thereof to incise (30) the anterior lens capsule 32 (col. 3, line 59 through col. 4, line 5 of Lash). Thus, while Lash does apply a dye to the razor sharp edge 24, this only mark only leaves a “visual imprint along the boundary of incision 30” (Id., at col. 4, lines 51-54). Thus, the device of Lash is no more accurate at placing the intended capsulorhexis than any of the other designs.

In contrast, as noted in paragraph [0018] of the present pending application, one novel and inventive aspect of at least one embodiment of the present relates to the creation and/or use of a ringed mark of dye or stain on the lens capsule of the eye to function as a reference template for facilitating the surgeon in performing a capsulorhexis procedure. In one embodiment, the size and shape of the mark corresponds to size and shape of the intended capsulorhexis. By creating the mark on the capsule at the desired position of the lens capsule, the surgeon has a relatively fixed positional template or point of reference for performing the capsulorhexis, which can significantly aid the surgeon in performing a capsulorhexis procedure, particularly in situations where the eye moves during the surgery. Such a mark, however, is by way of a “physical impression” on the capsule. As set forth in paragraph [0018],

In this aspect of the invention, regardless of the specific implementation, the objective is to physically mark or create an impression on the lens capsule that corresponds to the intended capsulorhexis. By creating a physical impression on the capsule at the desired position, the surgeon has a target or point of reference for performing the capsulorhexis. Because the mark is a physical impression, the surgeon can keep track of the target position on the lens capsule without the need for any type of tracking mechanism or device.

To impart any sort of “physical impression” on the capsule of the eye, a sufficient amount of force is necessary. Even if merely transferring a dye from the ring-shaped distal portion to the eye capsule, a force more than minute contact is required. Otherwise, any inadvertent contact would leave a mark or a false positive.

Moreover, during the marking procedure, once the desired placement of the anticipated capsulorhexis is located, the deployed ring-shaped distal portion will be oriented as adjacent and flush with the surface of the capsule of the eye as possible. However, there will nearly always be initial point contact of an edge of the distal portion with capsule. The requisite force is then necessary deform the distal portion into a position flush, or in full contact, with the concave surface of the capsule. Further force is then required to transfer the dye from the edge of the ring-shaped distal portion to the eye capsule, in order to leave a “physical impression”.

Accordingly, as set forth in amended claim 38, the ring-shaped distal portion includes “an upper blunt edge on one side” thereof, and “an opposed lower blunt edge on an opposite side thereof”, either one of which can contain the dye and/or contact the eye capsule. Thus, both the upper and lower opposed edges of the ring-shaped distal portion are blunt, as compared to one edge having a “razor sharp” edge, as described in Lash. Such dual sided blunt edge is necessary in the present invention since this device is applied to only “mark” the capsule (to determine if the placement of the anticipated capsulorhexis is located), rather than incise the capsule. Any such “razor sharp” edge (e.g., Lash) would certainly damage or cut the eye capsule during a marking procedure. In view of the foregoing arguments and amendments, withdrawal of the §102(b) rejection is respectfully requested.

In anticipation of a §103 rejection by the Examiner (i.e., that Lash anticipates replacing the one “razor sharp” edge 24 of the flexible band 22 with another smooth edge), the Applicant respectfully disagrees. The primary purpose of the device of Lash is to create an incision 30 on the anterior lens capsule of the eye. Merely substituting the “razor sharp” edge 24 of the flexible band 22 of the device of Lash with the dual sided blunt edges of the present invention would render Lash’s Capslrorhexis instrument inoperable for its intended purpose (i.e., to incise the lens capsule). Thus, the Applicant submits that Lash does not anticipate, suggest or mention a

ring-shaped distal portion “substantially contained in a plane when in the deployed condition, and having an upper blunt edge on one side of said plane, and an opposed lower blunt edge on an opposite side thereof”, as the present invention suggests.

In this rare instance, the device of Lash does not appreciate the existence of the problem solved by the present invention. *In re Nomiya et al.*, 184 U.S.P.Q. 607, 612-613 (CCPA 1975). In fact, the applicant's recognition of the problem is, in itself, strong evidence of the nonobviousness of the invention.

Conclusion

In light of the above amendments and remarks, the Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. It is believed that all claims now pending fully and patently define the subject invention over the cited art of record and are in condition for allowance.

If the Examiner has any questions concerning this case, the Examiner is respectfully requested to contact Michael L. Louie at (510) 663-1100.

The Commissioner is hereby authorized to charge any additional fees, including any additional extension fees, which may be required or credit any overpayment directly to the account of the undersigned, No. 50-4480 (Order No. MSKTP001).

Respectfully submitted,
Weaver Austin Villeneuve & Sampson LLP

/Michael L. Louie/
Michael L. Louie
Reg. No. 36,988

P.O. Box 70250
Oakland, CA 94612-0250
510-663-1100